

**Remarks**

This Amendment is responsive to the Office Action mailed May 11, 2004. Claims 1 and 27 have been amended. New claims 41-44 have been added.

Claims 1-2, 5-7, 9, 13 and 27-33 and 35-40 were rejected under 35 USC § 103(a) as being unpatentable over Besonen, et al. (U.S. Patent No. 5,307,753) (Besonen) in view of Küspert, et al. (U.S. Patent No. 5,810,339) (Küspert).

In the rejection, with reference to claims 1 and 27 and 35-40, Besonen was stated to provide a counterbalance capable of use on a tailgate or a motor vehicle which at least partially controls a load applied to the counterbalance. The counterbalance was stated to have an elastic element (30) that at least partially counters the load; a flexible extension limiter (25) that provides a stop which defines a fully extended position of the counterbalance and which counters loads applied to the counterbalance after the counterbalance is in the fully extended position.

In reference to claims 2 and 28, Besonen was stated to provide a counterbalance where the elastic element is a spring. Referring to claims 5-6 and 29-30, Besonen was stated to provide a counterbalance where the flexible extension limiter is a material strap.

Regarding claims 7, 9 and 31-32, Besonen was stated to provide a counterbalance including a protective housing that at least partially covers the elastic member and the flexible extension limiter. In reference to claims 13 and 33, the Examiner stated that Besonen provides the protective housing to include first and second tubes, with the first tube having an opening that telescopically receives a portion of the second tube.

The Examiner acknowledged that Besonen lacks the specific teaching of using the counterbalance in conjunction with a tailgate.

The Examiner stated that Küspert teaches the use of a counterbalance having a protective housing (22, 23) with a first end/tube (22) attached to a tailgate (12) and a second end/tube (23) attached to the vehicle body (10); wherein when the counterbalance is in a fully extended position, the protective housing is oriented at an angle between the tailgate and the vehicle body (Figure 1) and wherein the

counterbalance is in the fully retracted position, the protective housing is oriented in a vertical position with respect to the vehicle body and the tailgate. The Examiner stated that this is inherent from Figure 1.

The Examiner concluded that it would have been obvious to one of ordinary skill in the art at the time of the invention to have provided the counterbalance of Besonen on a tailgate as taught by Küspert in order to control the movement of the gate during opening and closing. The applicant respectfully traverses this rejection.

Claims 1 and 27 have been amended and patentably define over Besonen and Küspert since neither Besonen nor Küspert show a counterbalance mounted to a tailgate which moves with the tailgate and has a flexible extension limiter which provides a stop for the fully extended position of the tailgate. It simply would not be obvious to add a flexible extension limiter to Küspert which teaches a balancing element which uses two yokes which have detent corrugations to restrict undesired movement of the yokes and minimize over extension of the spring. Besonen does not teach or suggest the use of a counterbalance with a tailgate, and does not teach the use of a counterbalance between angled and vertical positions.

In rejecting claims 1 and 27 as being unpatentable over Besonen in view of Küspert, the Examiner failed to show any motivation, suggestion, or teaching of the desirability for combining the inventions of Besonen and Küspert. The teachings of Besonen and Küspert can be combined only if there is some suggestion or incentive in one of the references, or the general state of the art, to do so. *In re Rouffet*, 149 F.3d 1350, 47 USPQ2d 1453 (Fed. Cir. 1998). The Examiner, on the other hand, used impermissible hindsight in combining the counterbalance of Besonen with that of Küspert. The Examiner is not allowed to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. *Id* F.3d at 1953 and USPQ2d at 1457.

"Obviousness cannot be predicated on what is unknown. *In re Spormann*, 363 F.2d 444, 448, 150 USPQ 339, 452 (CCPA 1966). Such a

retrospective view of inherency is not a substitute for some teaching or suggestion supporting an obviousness rejection. See *In re Newell*, 891 F.2d 899, 901, 13 USPQ2d 1248, 1250 (Fed. Cir. 1989).” *Id* F.3d at 1534 and USPQ2d at 1957.

One of ordinary skill in the art would not be motivated to combine the teachings of Besonen with the teachings of Küspert because, firstly, the balancing elements of Besonen and Küspert are different types of balancing elements, one being a spring mechanism with a cord restraint and the other using two yokes with a series of detents as restraints. Furthermore, Besonen does not teach the use of a balancing element in conjunction with a tailgate or one that pivots between an angled and vertical orientation. One would not be motivated to replace the detents of the yokes of Küspert with a limiting cord of Besonen. There is simply no need for a cord in the Küspert device and no place on the Küspert housing for the additional elements of the limiting cord. The essence of hindsight is to piece together the disclosures of various prior art references without providing evidence of a suggestion, teaching or motivation to do so. *In re Dembiczak*, 175 F.3d 994, 50 USPQ2d 1614.

In applicant's view, Küspert teaches away from its combination with Besonen. In other words, the balancing elements shown in Küspert and Besonen are so different that they cannot be combined without destroying the function of one or the other. Therefore, Küspert teaches away from the design shown in Besonen, thereby not providing any motivation to combine the aforementioned teachings. *Tec Air, Inc. v. Denso Manufacturing Michigan Inc.*, 192 F.3d 1353, 52 USPQ2d 1294 (Fed. Cir. 1999).

As the Federal Circuit observes in *Tec Air*:

“There is no suggestion to combine ... if a reference teaches away from its combination with another source ... ‘A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be

discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant ... [or] if it suggests that the line of development flowing from the reference's disclosure is unlikely to be productive of the result sought by the applicant.' *In re Gurley* ... (Fed. Cir. 1994)." *Id.* F.3d at 1360 and USPQ2nd at 1298.

The present invention adds a flexible expansion limiter such as a strap to the spring to provide a solid stop to the further extension of the spring. There is simply no teaching or suggestion in Küspert to add a flexible expansion limiter such as a strap to a spring. What is the motivation to add a flexible extension limiter to the Küspert device which has detents to prevent movement of the yokes and over-extension of the spring? The benefit of adding a flexible strap to a tailgate counterbalance is apparent only after reviewing the present specification. Furthermore, the counterbalance mechanism of Besonen is used to absorb shock motion for use with marine or water equipment. There is simply no teaching or suggestion in Besonen for using its counterbalance mechanism with a tailgate or for pivoting the counterbalance between angled and vertical positions. Moreover, as previously stated, Besonen is simply non-analogous art.

In conclusion, Besonen simply does not teach or suggest a spring housing which moves with respect to the tailgate between a vertical and angled position. Rather, Besonen teaches the use of a counterbalance with marine or water equipment which does not pivot or rotate during use. Küspert simply does not teach the use of a strap with a spring counterbalance. Accordingly, amended claims 1 and 27, and claims 2, 5, 6, 7, 9, 13, 35, 36, 37 and 28, 29, 30, 31, 32, 33, 38, 39, and 40 dependent thereon are in condition for allowance.

New claims 41 through 44 have been added to depend from independent claims 1 and 27. These claims recite that the inner tube of the counterbalance housing has ribs projecting from an outside surface to provide a gap between the outer and inner tubes. This facilitates substantially free movement of the inner tube with respect to the outer tube. These claims are supported by Figure

6 of the specification. Neither Küspert nor Besonen teaches or suggests this feature in their counterbalance devices. Accordingly, claims 41-44 are patentably distinct over the prior art of record and are also in condition for allowance.

**Conclusion**

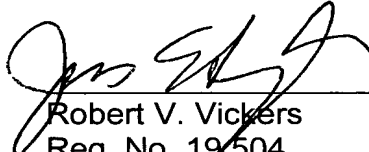
In view of the above arguments and comments presented, it is respectfully submitted that all pending claims are patentably distinct and unobvious over the art of record.

Allowance of all claims and early notice to that effect is respectfully requested.

Respectfully submitted,

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